

Remarks

I. Introduction

Claims 1-4, 6-32, 34, and 36-57 are presented for examination. Claims 5, 33, and 35 have been canceled, and claims 1, 3-4, 13, 36, 39 and 49 have been amended. Claim 57 has been added.

II. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 1, 13, 24, 32, 33, 34, 35-39, 42, 46, 47, and 49 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

First, the Examiner states that in claims 1, 13, 24, and 32-34, the phrase "may be" renders the claim indefinite. While Applicants do not believe this claim language is indefinite under MPEP § 2173.05(d), for purposes of expediting prosecution, Applicants have now amended the claims to substitute the wording "is optionally", thereby rendering this ground of rejection moot. The claim term "optionally" has been upheld as not being indefinite under Section 112, second paragraph. See e.g. Ex parte Cordova, 10 USPQ2d 1949 (Bd. Pat. App. & Int'f 1988); Ex parte Wu, 10 USPQ2d 2031 (Bd. Pat. App. & Int'f 1989). Applicants respectfully note that since this amendment was made only to clarify the language of the claim, it is not narrowing in any respect.

Second, the Examiner states that in claims 35-39, 42, 46, 47, and 49, the term "trioxolane" is not clearly defined and/or specified, the position on the trioxolane ring where the functional group is attached is not specified, and the reagent is also not known. Applicants have now canceled claim 35 and added new claim 57 (from which claims 36-39, 42, 46, 47, and 49 now ultimately depend) to define these parameters, thereby rendering this ground of rejection moot.

Third, the Examiner states there is insufficient basis for recitation of the limitation "Y" in line 1 of claims 3 and 5. Claim 3 has now been amended to depend from claim 2 instead of claim 1, thereby rendering this ground of rejection moot. Claim 5 has been canceled, thereby also rendering the ground of rejection with respect to this claim moot.

Finally, the Examiner states that claim 55 is objectionable as being a substantial duplicate of claim 5. Since claim 5 has been canceled, this ground of rejection is now rendered moot.

III. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claim 33 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 33 has now been canceled, thereby rendering this ground of rejection moot.

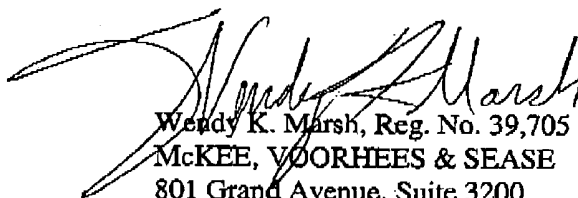
IV. Obviousness-Type Double Patenting

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,486,199 B1. Applicants are hereby submitting a terminal disclaimer, thereby rendering this ground of rejection moot.

V. Conclusion

It is believed that a one month extension of time is due in connection with this Amendment (June 24, 2004 to July 24, 2004). Accordingly, please charge Deposit Account No. 26-0084 the amount of \$55.00 for this extension. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Respectfully submitted,



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